

REMARKS

Claims 1-36 are pending in the subject application. Claims 20-32, 35, and 36 have been withdrawn by the Examiner from consideration subject to a restriction requirement. Claims 1-19 and 33-34 have been rejected. Applicant has amended independent claims 1 and 33, has canceled claims 17, 18, and 34, and has not added any claims. Accordingly, claims 1-16, 19 and 33 are presently being examined.

In view of the following Amendment and Response, applicant respectfully requests that the Examiner reconsider and withdraw the rejections made in the outstanding Office Action.

Support for the Amendments

Applicant has amended independent claims 1 and 33 in order more particularly point out and distinctly claim the subject matter of applicant's compartmentalized storage system for temporarily storing and subsequently mixing at least two different substances. Specifically, applicant has canceled claims 17 and 18 and incorporated the subject matter therein into independent claim 1, and the claims dependent thereon. Claim 1 now recites that the first storing compartment comprises "a tearable seal" and that "the tearable seal and the frangible seal are located adjacent to each other such that pressure to open the tearable seal will break the frangible seal". Applicant has similarly canceled claim 34 and incorporated the subject matter therein into independent claim 33. Applicant has entered these amendments in order to overcome the Examiner's rejections.

Applicant has also amended the description of Figure 2 in the specification to recite that the first and the second compartments are attached to each other by more than two common sides. These amendments to the specification are fully supported in the specification as originally filed, for example in claim 6, and thus no new matter is

introduced by these amendments in accordance with 35 U.S.C. Section 132. Accordingly, applicant requests entry of these amendments.

Applicant has also amended the Figures to provide a replacement Figure 2 to illustrate that the first and the second compartments are attached to each other by more than two common sides. These amendments to the Figures are fully supported in the specification as originally filed, for example in claim 6, and thus no new matter is introduced by these amendments in accordance with 35 U.S.C. Section 132. Accordingly, applicant requests entry of these amendments.

Restriction Requirement

The Examiner initially withdrew claims 10-36 from further consideration as being drawn to a nonelected invention. Applicant timely traversed the restriction requirement. After review of Examiner Madsen's restriction, the present Examiner issued a new restriction requirement dividing the claims among Species I (Figure 1), Species II (Figure 2), and Species III (Figure 3). Because applicant had already elected the first set of claims that includes the wipes and two other substances within the container, the Examiner will examine Figures 1 and 2 together at this time. Hence, claims 1-19 and 33-34 are presently being examined and claims 20-32 and 35-36 have been withdrawn as a non-elected embodiment.

Drawings

The Examiner has objected to the drawings on the basis that the drawings must show every feature of the invention specified in the claims. The Examiner states that the first and second compartment attached to each other by more than two common sides must be shown or the features canceled from claim 6. Applicants' replacement

Figure 2, submitted herewith, and amendment to the specification obviates the Examiner's objection.

As set out above, applicants have enclosed replacement Figure 2, and have amended the specification to describe replacement Figure 2, describing how the first and second compartment are attached to each other by more than two common sides as recited in claim 6. Replacement Figure 2 parallels original Figure 2, which Figure shows how the first and second compartment are attached to each other by two common sides as recited in claim 5.

Hence, the Examiner's objection to the drawings should be withdrawn.

Objection to the Specification and Rejection of Claim 6 Under 35 U.S.C. Section 112, first paragraph.

The Examiner has objected to the specification and under 35 U.S.C. Section 112, first paragraph as failing to provide an adequate written description of the invention, and failing to adequately teach how to make and/or use the invention. The Examiner states that the specification does not disclose the first and second compartment attached to one another on more than two common sides. The Examiner has rejected claim 6 under 35 U.S.C. Section 112, first paragraph, for the reasons set forth in the objection to the specification. Applicants' replacement Figure 2 submitted herewith and amendment to the specification to describe replacement Figure 2, obviates the Examiner's objection and rejection.

As set out above, applicants have enclosed replacement Figure 2, and have amended the specification to describe replacement Figure 2, describing how the first and second compartment are attached to each other by more than two common sides as recited in claim 6. Replacement Figure 2 parallels original Figure 2, which Figure

shows how the first and second compartment are attached to each other by two common sides as recited in claim 5.

Hence, the Examiner's objection to the specification and rejection of claim 6 under 35 U.S.C. Section 112, first paragraph, should be withdrawn.

Rejection of Claims 6 and 33-34 rejected under 35 U.S.C. Section 112, second paragraph.

The Examiner has rejected claims 6 and 33-34 under 35 U.S.C. Section 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The Examiner states that the specification does not disclose the first and second compartment attached to one another on more than two common sides. The Examiner further states that in claim 33, the first occurrence of "the tearable seal" lacks proper antecedent basis, and in claim 34, the tearable seal appears to be of the same seal as claim 33. Applicants' new Figure 2A submitted herewith and amendment to the specification to describe Figure 2A, and amended claim 33 obviates the Examiner's objection.

As set out above, applicants have enclosed replacement Figure 2, and have amended the specification to describe replacement Figure 2, describing how the first and second compartment are attached to each other by more than two common sides as recited in claim 6. Replacement Figure 2 parallels original Figure 2, which Figure shows how the first and second compartment are attached to each other by two common sides as recited in claim 5.

Applicant has canceled claim 34 and incorporated the subject matter therein into independent claim 33. Claim 33 now recites that the first storing compartment comprises "a tearable seal" and that "the tearable seal and the frangible seal are located

adjacent to each other such that pressure to open the tearable seal will break the frangible seal".

Hence, the Examiner's rejection of claims 6 and 33-34 under 35 U.S.C. Section 112, second paragraph, should be withdrawn.

Rejection of Claims 1-4, 7-9, 11, 13, 19, and 33 under 35 U.S.C. Section 102(b) as being Anticipated by *Kasianovitz et al.*

The Examiner has rejected claims 1-4, 7-9, 11, 13, 19, and 33 under 35 U.S.C. Section 102(b) as being anticipated by United States patent no. 5,616,337 (*Kasianovitz et al.*). The Examiner states that *Kasianovitz et al.* discloses a package with two chambers, one chamber holding a liquid and the other chamber holding a pad and powder or a pad and liquid. The Examiner argues that a breakable seal 18 allows the mixture of the two contents after it is ruptured and the powder that dissolves in the liquid would produce a foaming reaction. Applicants' claims as amended obviate the Examiner's rejections.

Applicants' claim 1, as amended, recites a compartmentalized storage system for temporarily storing and subsequently mixing at least two different substances. The system comprises (a) a first storing compartment having a front and a back and a plurality of sides, defining a first cavity portion, and a tearable seal, wherein a solid sorbing substrate and a first substance are stored in the first storing compartment; and (b) a second storing compartment having a front and a back and a plurality of sides, defining a second cavity portion, wherein a second substance is stored in the second storing compartment. The first and the second compartments are attached to each other by at least one common side, which common side comprises a frangible seal connecting the first and the second compartments. The tearable seal and the frangible seal are located adjacent to each other such that pressure to open the tearable seal will break the

frangible seal and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment.

Applicants' claim 33, as amended, recites a method for using a compartmentalized storage system to temporarily store and subsequently mix at least two different substances. The method comprises the steps of (A) providing a compartmentalized storage system comprising (a) a first storing compartment having a front and a back, a plurality of sides, defining a first cavity portion, and a tearable seal, wherein a solid sorbing substrate and a first substance are stored in the first storing compartment; and (b) a second storing compartment having a front and a back and a plurality of sides, defining a second cavity portion, wherein a second substance is stored in the second storing compartment. The first and the second compartments are attached to each other by at least one common side, which common side comprises a frangible seal connecting the first and the second compartments. The tearable seal and the frangible seal are located adjacent to each other such that pressure to open the tearable seal will break the frangible seal and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment. The method further comprises (B) applying force to the tearable seal to break the seal and thereby allow the second substance in the second storing compartment to be mixed with the solid sorbing substrate and the first substance in the first storing compartment; and (C) removing the solid sorbing substrate, mixed with the first substance and the second substance, through the broken tearable seal in the first storing compartment.

The *Kasianovitz et al.* reference discloses a unit dose package comprising a web having two compartments separated by a frangible seal. A liquid is contained

within the first compartment and an applicator is contained within the second compartment separate from the web.

The Examiner has not rejected claims 17, 18, and 34. As set out above, applicant has canceled claims 17 and 18 and incorporated the subject matter therein into independent claim 1, and the claims dependent thereon. Claim 1 now recites that the first storing compartment comprises "a tearable seal" and that "the tearable seal and the frangible seal are located adjacent to each other such that pressure to open the tearable seal will break the frangible seal". Applicant has similarly canceled claim 34 and incorporated the subject matter therein into independent claim 33. *Kasianovitz et al.* does not teach a tearable seal and a frangible seal located adjacent to each other such that pressure to open the tearable seal will break the frangible seal.

Hence, the Examiner's rejection of claims 1-4, 7-9, 11, 13, 19, and 33 under 35 U.S.C. Section 102(b) as being anticipated *Kasianovitz et al.* should be withdrawn.

Rejection of Claim 5 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of *Stupar et al.*

The Examiner has rejected claim 5 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of United States patent no. 5,353,927 (*Stupar et al.*). The Examiner states that *Kasianovitz et al.* does not show more than one point of attachment but that *Stupar et al.* suggests an arrangement of compartments wherein the first and second compartments are connected at two locations for the mixing of the contents. The Examiner states that such an arrangement allows the compartments to be sealed tight to one another. Applicants' claims as amended obviate the Examiner's rejections.

The *Stupar et al.* reference discloses a plural compartment package for mixing materials. The package comprises a first sheet of packaging material and a second

sheet of packaging material overlapping the first sheet of packaging material. The first and second sheets of packaging material are joined together such that an area is defined there between. A third sheet of packaging material is located between and joined to the first and second sheets of packaging material such that a first compartment for holding a first material is defined between the third sheet of packaging material and the first sheet of packaging material. A second compartment for holding a second material is defined between the second and third sheets of packaging material. The third sheet of packaging material has a weakened area which is rupturable upon the application of pressure for enabling the first and second materials to mix together. A non-porous, rupturable cap means is secured to the third sheet of packaging material and overlays the weakened area of the third sheet of packaging material for preventing discharge of the first material from the first compartment until the application of the pressure ruptures both the weakened area of the third sheet of packaging material and the cap means whereby the first material is discharged from the first compartment into the second compartment for mixing with the second material.

As set out above, applicant has canceled claims 17 and 18 and incorporated the subject matter therein into independent claim 1, and the claims dependent thereon. Claim 1 now recites that the first storing compartment comprises "a tearable seal" and that "the tearable seal and the frangible seal are located adjacent to each other such that pressure to open the tearable seal will break the frangible seal". Applicant has similarly canceled claim 34 and incorporated the subject matter therein into independent claim 33. Neither *Kasianovitz et al.* nor *Stupar et al.* teach a tearable seal and a frangible seal located adjacent to each other such that pressure to open the tearable seal will break the frangible seal.

Hence, the Examiner's rejection of claim 5 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of *Stupar et al.* should be withdrawn.

Rejection of Claims 6, 10, 12-17, and 34 under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of "Official Notice".

The Examiner states that claims 6, 10, 12-17, and 34 are rejected under 35 U.S.C. Section 103(a) as being unpatentable over *Kasianovitz et al.* in view of "Official Notice". The Examiner states that although *Kasianovitz et al.* shows only one common side of attachment, it would have been obvious to arrange the compartments in a manner to have multiple connecting points for the compartments to ensure the sealability of the sides. With respect to the different contents and reactions, the Examiner argues that it would have been obvious to provide the desired articles or agent within the respective compartments to produce the desired result. With respect to the tearable seal, the Examiner argues that although the tearable seal shown in *Kasianovitz et al.* does not extend to the first compartment, it is conventionally known to provide a tearable seal within the compartment to allow dispensing of that particular substance only. Applicants' claims as amended obviate the Examiner's rejections.

As set out above, applicant has canceled claims 17 and 18 and incorporated the subject matter therein into independent claim 1, and the claims dependent thereon. Claim 1 now recites that the first storing compartment comprises "a tearable seal" and that "the tearable seal and the frangible seal are located adjacent to each other such that pressure to open the tearable seal will break the frangible seal". Applicant has similarly canceled claim 34 and incorporated the subject matter therein into independent claim 33. *Kasianovitz et al.* does not teach a tearable seal and a frangible seal located

adjacent to each other such that pressure to open the tearable seal will break the frangible seal.

The Examiner cites no reference teaching or suggesting the use of applicant's tearable seal and frangible seal located adjacent to each other such that pressure to open the tearable seal will break the frangible seal. In the absence of such teachings, the Examiner cannot assert that "it is conventionally known to provide a tearable seal within the compartment to allow dispensing of that particular substance only".

[A]s a matter of law under 35 U.S.C. Section 103, the examiner must substantiate his "suspicions" on the basis of facts drawn from proper prior art. The issue to be resolved requires more than "suspicions;" it requires facts.... The provisions of section 103 must be followed realistically to develop the factual background against which the section 103 determination must be made. All of the facts must be considered.... In re Lunsford, 357 F.2d 380, 391, 148 U.S.P.Q. 716, 725 (C.C.P.A. 1966) [emphasis in original].

The provisions of Section 103 must be followed realistically to develop the factual background against which the Section 103 determination must be made. It is not proper within the framework of Section 103 to pick and choose from any one reference only so much of it as will support a given position to the exclusion of other parts necessary for the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. The references of record fail to teach or suggest applicant's invention as a whole.

Obviousness of a composition or process must be predicated on something more than it would be obvious "to try" the particular component recited in the claims or the possibility it will be considered in the future, having been neglected in the past. *Ex parte Argabright et al.* (POBA 1967) 161 U.S.P.Q. 703. There is usually an

element of "obvious to try" in any research endeavor, since such research is not undertaken with complete blindness but with some semblance of a chance of success. "Obvious to try" is not a valid test of patentability. *In re Mercier* (CCPA 1975) 515 F2d 1161, 185 U.S.P.Q. 774; *Hybritech Inc. v. Monoclonal Antibodies. Inc.* (CAFC 1986) 802 F2d 1367, 231 U.S.P.Q. 81; *Ex parte Old* (BPAI 1985) 229 U.S.P.Q. 196; *In re Geiger* (CAFC 1987) 815 F2d 686, 2 U.S.P.Q.2d 1276. *In re Dow Chemical Co.* (CAFC 1988) F2d, 5 U.S.P.Q.2d 1529. Patentability determinations based on that as a test are contrary to statute. *In re Antonie* (CCPA 1977) 559 F2d 618, 195 U.S.P.Q. 6; *In re Goodwin et al.* (CCPA 1978) 576 F2d 375, 198 U.S.P.Q. 1; *In re Tomlinson et al.* (CCPA 1966) 363 F2d 928, 150 U.S.P.Q. 623. A rejection based on the opinion of the Examiner that it would be "obvious to try the chemical used in the claimed process which imparted novelty to the process does not meet the requirement of the statute (35 U.S.C. 103) that the issue of obviousness be based on the subject matter as a whole. *In re Dien* (CCPA 1967) 371 F2d 886, 152 U.S.P.Q. 550; *In re Wiaains* (CCPA 1968) 397 F2d 356, 158 U.S.P.Q. 199; *In re Yates* (CCPA 1981) 663 F2d 1054, 211 U.S.P.Q. 1149. Arguing that mere routine experimentation was involved overlooks the second sentence of 35 USC 103. *In re Saether* (CCPA 1974) 492 F2d 849, 181 U.S.P.Q. 36. The issue is whether the experimentation is within the teachings of the prior art. *In re Waymouth et al.* (CCPA 1974) 499 F2d 1273, 182 U.S.P.Q. 290. The fact that the prior art does not lead one skilled in the art to expect the process used to produce the claimed product would fail does not establish obviousness. *In re Dow Chem. Co.* (CAFC 1988) 5 U.S.P.Q.2d 1529.

In view of the foregoing Amendment and Response, applicants request reconsideration pursuant to 37 C.F.R. Section 112 and allowance of the claims pending in this application. Applicant requests the Examiner to telephone the undersigned attorney should the Examiner have any questions or comments which might be most

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expeditiously handled by a telephone conference. No fee is deemed necessary in connection with the filing of this Amendment and Response. If any fee is required, however, authorization is hereby given to charge the amount of such fee to Deposit Account No. 13-4822.

Respectfully submitted,

By 
RICHARD R. MUCCINO
Attorney For Applicant(s)
Registration Number 32,538

Direct communications to:
Richard R. Muccino
758 Springfield Avenue
Summit, New Jersey 07901
tel. (908) 273-4988
fax (908) 273-4679